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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/529,543 04/14/00 SCHWARZ

E MERCK-2084

EXAMINER

023599 HM12/0420  
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TRAN, S

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/529,543

Applicant(s)

Schwarz et al.

Examiner

Susan Tran

Group Art Unit

1615



☒ Responsive to communication(s) filed on Feb 13, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Receipt is acknowledged of applicants' Preliminary Amendment A filed 04/14/00, Information Disclosure Statement filed 08/10/00, Change of Address filed 01/31/01, Requested for Extension of Time filed 02/13/01, and Amendment B filed 02/13/01.

#### *Response to Arguments*

1. Applicant's arguments filed 02/13/01 have been fully considered but they are not persuasive. The examiner maintains the original rejections and thus, claims 1-5, 9, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Virtanen et al. USPN 5,536,526 ('526); claims 1-5, 12-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Olinger et al. USPN 5,204,115 ('115); and claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virtanen et al. ('526), in view of Schwarz et al. USPN 5,958,471, and Mizumoto et al. USPN 5,576,014.

Applicant argues that Virtanen and Olinger do not teach or disclose a tableting aid produced by dissolving the xylitol in a solvent. Contrary to the applicant's argument, applicant's claims (except claims 10 and 11) are drawn to a composition, the preamble does not carry any patentable weight. Therefore, the patentability of a tableting aid does not depend on its method of production.

Applicant argues that Virtanen does not teach the desirability of dissolving the xylitol crystals in a solvent and therefore, there is no *prima facie* case of obviousness. However,

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example 2 of Virtanen discloses xylitol powder is mixed with sorbitol syrup solution to make a syrup solution. Accordingly, it is the position of the examiner that such language does suggest the desirability to dissolve xylitol powder in a solution. Further, Schwarz in column 2, lines 7-46 does teach the step of preparing an aqueous solution of at least two polyols selected from the group consisting of xylitol and mannitol. Mizumoto is relied on solely for the teaching of analgesics agent in a composition comprising xylitol, lactose, mannitol or sorbitol that can be compressed into tablet. Thus, it would have been prima facie obviousness case, because the references teach and suggest xylitol in solution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE  
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